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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,786	10/05/2001	Yoshitaka Sasaki	110796	2034

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EXAMINER

TUGBANG, ANTHONY D

ART UNIT PAPER NUMBER

3729

DATE MAILED: 01/30/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/970,786

Applicant(s)

SASAKI ET AL.

Examiner

A. Dexter Tugbang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-16 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of the invention of Group I, Claims 6-16, in Paper No. 7 is acknowledged. The traversal is on the ground(s) that a thorough search for Group I would be encompassed by the same search for Group II, thus, there would be no serious burden to search and examine both inventions. This is not found persuasive because the searches would be non-coextensive. For example, the product of Group II does not require any etching and lapping of slider material and the slider material made in the product of Group II can be made by coating or patterning techniques without any lapping or etching. Therefore, the search for both of the inventions of Groups I and II would place a serious burden on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-5 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8.

Specification

3. The abstract of the disclosure is objected to because the abstract appears to be greater than 150 words and is not directed to the claimed invention of a method of manufacturing. Correction is required. See MPEP § 608.01(b).

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: A Method of Manufacturing a Slider of a Thin-Film Magnetic Head.

Claim Objections

5. Claims 7 and 8 are objected to because of the following informalities.

In Claim 7, the phrase of "a concavity/convexity" (line 3) is awkwardly worded. The claim would be considered more favorably if it were amended to read as --concave and convex portions--, as this would agree with the language used in the specification (pages 32-33). Appropriate correction is required.

Similar changes are also suggested with the same language in Claim 8.

Allowable Subject Matter

6. Claims 6-16 are allowed.

7. The following is a statement of reasons for the indication of allowable subject matter.

With respect to Claim 6, the prior art does not teach all of the limitations of the claimed invention including forming the medium facing surface in the slider material by lapping a surface of the medium facing layer facing toward the recording medium and a surface of the insulating portion facing toward the recording medium.

The closest prior art reference directed to the above features is directed to Sone et al (U. S. Patent 5,634,259). Sone teaches forming a slider material including a substrate (core slider 32), a thin-film magnetic head element (magnetic film 32) and an insulation portion (either one of layers 37 or 39 in Fig. 3B). The protective film 36 (in Figs. 3A and 3B) can be read as the

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claimed "medium facing layer". Sone teaches forming a medium facing surface by lapping or grinding a surface of the medium facing layer 36 facing toward the recording medium (see col. 7, lines 50-52). However, nowhere does Sone ever lap a surface of the insulation portion (either insulating films 37 or 39) facing toward the recording medium. Sone only performs lapping on the medium facing layer 36 and not on any surface of the insulating portion.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Japanese Patent Publication JP 59-142776 is cited for etching slider materials.

9. This application is in condition for allowance except for the following formal matters.

The examiner suggests making the above changes to the specification and Claims 7 and

8.

Claims 1-5 are drawn to an invention nonelected with traverse in Paper No. 8. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

10. Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

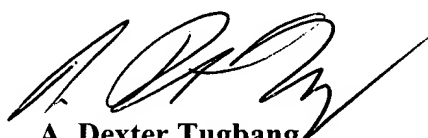
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Dexter Tugbang whose telephone number is 703-308-7599.

The examiner can normally be reached on Monday - Friday 7:00 am - 3:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



A. Dexter Tugbang
Primary Examiner
Art Unit 3729

January 26, 2004